

### REMARKS

Claims 1-2 and 4-19 are presently pending in this application. Claim 1 and 19 were amended in this response. No new matter has been introduced as a result of the amendment. Support for the amendments may be found, for example, on page 4, line 25 - page 5, line 23, page 13, lines 9-21 and page 14, lines 6-22 of the amended specification. Favorable reconsideration is respectfully requested.

Claims 1, 2, 4 and 19 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 1, 2, 4 and 19 were also rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement. Applicant respectfully traverse these rejections.

Under the present amendments, the claims more clearly recite a configuration where only a part of the signaling information is configured to a circuit-switching communication network standard, while the remaining part is configured as second signaling information according to the signaling standard of the packet-switching communication network. Applicant wishes to point out that the previous claims were not reciting that the first signaling information was being transmitted over a circuit-switched connection, rather that the signaling information conformed to a circuit-switched format (i.e., configuration). Accordingly, Applicant submits the rejection under 35 U.S.C. §112, second paragraph is overcome. Withdrawal of the rejection is earnestly requested.

Regarding the question of enablement, the analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;

- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole (MPEP 2164.01, 2164.01(a)). The specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. *In re Borkowski*, 422 F.2d 904, 908, 164 USPQ 642, 645 (CCPA 1970).

The present disclosure teaches that the concept of converting data protocols between a packet-switched and circuit-switched communication network is generally known:

Components such as terminals, gateways and gatekeepers are provided and defined for transmitting voice according to the H.323 Standard. Terminals are terminating devices which are connected to the packet-switching communications network. In packet-switching communications networks it is necessary for the subscriber to log on with his/her terminal. A gateway is used as an interface for converting the data protocols between the packet-switching communications network and the circuit-switching communications network. A gatekeeper is used to administer and to check user services and network capacities of a packet-switching communications network according to the H.323 Standard. The addressing of an incoming call also takes place in the gatekeeper in the packet-switching communications network. Each subscriber has an address in the packet-switching communications network. The telephone number which is selected by a calling subscriber is converted by the gatekeeper to the address of the called subscriber in the packet-switching communications network. In this way, the H.323 Standard can be used to transmit telephone calls over the Internet and in networks based on an Internet protocol.

(page 2, amended specification, line 21 - page 3, line 6).

However, in the prior art, certain services, such as 3-way conferencing, call forwarding, call playback, etc. are not supported for voice connections using a packet-switched communication protocol (amended specification page 4, lines 1-7; see also page 2, lines 3-27). In the recited claims, only a portion of the first signaling information is converted into second signaling information (packet-switched) using the interface unit and is transmitted as second signaling information between the interface unit and the first subscriber. Under the recited configuration, the signaling information of the network element that can be converted into signaling information of the packet-switching communications network, i.e. for which there is corresponding equivalent signaling information in the packet-switching communications network, is transmitted using the signaling system of the packet-switching communications network, or that this signaling information is used to carry out the subscriber signaling via the packet network (see page 5, lines 14-23; col. 14, lines 6-23).

A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. As is recognized by the Federal Circuit and the MPEP, "[i]t is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971) (MPEP 2164.04). Accordingly, Applicant submits the present claims are enabled by the disclosure, and earnestly requests the rejection under 35 U.S.C. §112, first paragraph, be withdrawn.

In light of the above, Applicants respectfully submit that independent claims 1 and 19 of the present application, as amended, as well as claims 2 and 4-18 which respectfully depend therefrom, are both novel and non-obvious over the art of record. Accordingly, Applicants

respectfully request that a timely Notice of Allowance be issued in this case. It is further submitted that no fees are due in connection with this response at this time. However, if any fees are due in connection with this application as a whole, the Examiner is authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the attorney docket number (0112740-211) on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Peter Zura

Reg. No. 48,196

Customer No.: 29177

Phone: (312) 807-4292

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